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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/867,235 | 05/29/2001 | Larry Richard Robinson | 8569 | 5928 |

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THE PROCTER & GAMBLE COMPANY
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EXAMINER

WELLS, LAUREN Q

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1617

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,235

Applicant(s)

ROBINSON ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claims 27-31 are pending. The Amendment filed 12/8/03, amended claims 27-31.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/8/03 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 27-31 rejected under 35 U.S.C. 102(b) as being anticipated by Rouquet et al. (EP 0908175) as evidenced by Stedman's and Mosby's Medical Dictionary.

Rouquet et al. disclose stable topical compositions containing solid elastomeric organopolysiloxane and spherical particles. Exemplified is a water-in-oil make-up foundation comprising, dimethicone copolyol (silicone oil), cyclomethicone (silicone oil), octyl methoxycinnamate (oil-soluble sunscreen anti-inflammatory agent), and KSG-16 (crosslinked silicone elastomer), wherein foundations are applied to the skin. Thus, Rouquet et al. and the instant invention both teach a method of applying to the skin a composition comprising a water-

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in-oil emulsion comprising a silicone oil, a crosslinked silicone elastomer, and a skin care active, all of which are in the oil-phase. See pages 10-11.

Stedman's Medical Dictionary, 27th Edition, defines a sunscreen as a topical product that protects the skin from ultraviolet induced erythema, and Mosby's Medical Dictionary, 4th Edition, defines erythema as redness or inflammation of the skin or mucous membranes.

The claims are directed to a method of applying a composition comprising oil-soluble skin care active, silicone oil, and silicone elastomer to the skin. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches application to the skin of compositions containing the same components as instantly claimed, which would inherently enhance the delivery of the oil soluble skin care active and regulate the condition of the skin, as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

In a water-in-oil emulsion, water is the discontinuous phase and oil is the continuous phase.

Response to Arguments

Applicant argues, "There is no contemplation in Rouquet that the silicone elastomers enhance delivery of actives. They are used to maintain the suspension of the spherical particles

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and to provide a pleasant skin feel". This argument is not persuasive. It is respectfully pointed out that Rouquet teach a method of applying to the skin a composition comprising the same ingredients as the instant claim. Since a compound and its properties are inseparable, the application to the skin of the water-in-oil foundation exemplified by Rouquet has the property of enhancing the delivery of actives. It is further respectfully pointed out that Applicant has provided no showing of unexpected results.

Applicant argues, "Rouquet provides skin care compositions with high percent by weight of spherical particles. There is no contemplation of the use of these compositions to deliver actives into the skin". This argument is not persuasive. It is respectfully pointed out that the open-ended transitional term, "comprising" excludes no ingredients from the composition recited within the instant method. Thus, this argument is not relevant.

Applicant argues, "EP '175 relates to both oil-in-water and water-in-oil compositions. . .The stability of such particles. . .is important since these particles are relied upon to absorb oils while not drying on the skin, thereby maintaining cosmetic properties". This argument is not persuasive. Again, EP '175 (Rouquet) teaches a method of applying to the skin a composition comprising an oil soluble anti-inflammatory, a silicone oil and a silicone elastomer, thus meeting all the limitations of the instant claims. The additional recitation of spherical particles in Rouquet is not relevant. Furthermore, the citation of Rouquet relied upon by the Examiner, exemplifies a water-in-oil emulsions.

Applicant argues, "there is no teaching that compositions with specific components disclosed in the instant specification provide a significant skin care active delivery benefit. Additionally, while several broad categories of skin care actives are disclosed for use with the

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compositions of Rouquet, there is no guidance provided which would lead one of skill in the art to choose oil-soluble actives, especially those now claimed". This argument is not persuasive. Again, it is respectfully pointed out that Applicant is arguing unexpected results, when no data has been provided to show unexpected results. Second, Rouquet, as pointed out in the above rejection, exemplifies a method of applying to the skin a composition containing all the ingredients as instantly claimed. Thus, there is specific guidance as to what oil-soluble active is incorporated into the composition, i.e., octyl methoxycinnamate.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER